

**REMARKS/ARGUMENTS**

Applicants thank the Examiner for a careful review of this application. Claims 9-17 and 22-33 have been rejected. Claims 9-17 and 22-33 are pending. Claims 11-17 have been amended to correct Applicants' inadvertent use of double brackets rather than underline markings to indicate added claim text in Applicants' response mailed March 27, 2006 and, therefore, Applicants respectfully request entry of these form-based amendments. It is respectfully submitted that the pending claims define allowable subject matter. Applicants respectfully request reconsideration of the application in view of the above amendments and the following remarks submitted in support thereof.

**Discussion of Rejection of Claims 9-17 and 22-33 under 35 U.S.C. § 103(a)**

In Section 3 of the Office Action, the Examiner rejected Claims 9-17 and 22-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. 2002/0133545 to Fano et al. in view of U.S. Pub. No. 2002/0187775 to Corrigan et al.

The Examiner's rejection is respectfully traversed. As acknowledged by the Examiner, Fano et al. do not teach or suggest predicting a set of services from a plurality of services that a user is expected to utilize within a predefined period of time based on user profile information by utilizing a ranker filter module, as recited in independent Claims 9, 22, and 30. See Final Office Action mailed July 6, 2006 at page 4 ("Fano et al. does not explicitly disclose a ranker filter module"). As further acknowledged by the Examiner, Fano et al. do not teach or suggest a user action proxy that detects user actions and monitors each service subscribed to by a user for a pattern common to at least two services, as recited in independent Claim 9. See Final Office mailed July 6, 2006 at page 4 ("Fano et al. does not

explicitly disclose ... a user action proxy”). However, the Examiner asserts that Corrigan et al. teach these elements missing from Fano et al. Applicants respectfully disagree.

First, regarding whether Corrigan et al. teach or suggest predicting (using a ranker profiler module) services that a user is expected to utilize within a predefined period of time based on user profile information, the Examiner states that Corrigan et al. teach, at paragraph 70 of page 3, an approach that enables subscribers “to select their own portfolio of personalized services.” See Final Office Action mailed July 6, 2006 at page 4. The Examiner then asserts that because Corrigan et al. “allow[] a mobile subscriber to customize the delivery of services based upon [a] user profile,” the ranker filter module of the claimed invention is “rendered” by Corrigan et al. See Final Office Action mailed July 6, 2006 at page 4. However, as recited in the claimed invention, it is a **“ranker filter module”** (not a user/subscriber) that is **“predicting”** (not selecting by direct interaction) a set of services from a plurality of services that a user is expected to utilize within a predefined period of time. The Examiner has chosen to ignore the language of the claimed invention and proceeded as though the language were not in the claims. Nevertheless, “[a]ll words in a claim **must** be considered in judging the patentability of that claim against the prior art.” See In re Wilson 165 USPQ 494, 496 (CCPA 1970) (emphasis added); MPEP § 2143.03.

Moreover, nowhere do Corrigan et al. teach or suggest a service selection being made without direct interaction from the user/subscriber, from services that a **“user is expected to utilize within a predefined period of time,”** as recited in the claimed invention. For example, on page 6, paragraph 158, Corrigan et al. teach dynamic management objects that monitor a pattern of usage by a subscriber and, without direct interaction from the subscriber, suggest an automatic addition of services to a subscriber’s personal list from services that are not already on the subscriber’s personal list. Likewise, on page 6, paragraph 159, Corrigan et

al. teach alerting a subscriber to new services based on whether the services match the subscriber's observed interests. Again, the Examiner has chosen to ignore the language of the claimed invention and proceeded as though the language were not in the claims.

Second, regarding whether Corrigan et al. teach or suggest a user action proxy that detects user actions and monitors each service subscribed to by a user for a pattern common to at least two services, the Examiner's rejection likewise fails to consider all of the words in the claimed invention. Specifically, the Examiner asserts that "[d]ynamic management objects [which] co-operate with session management objects to monitor the pattern of usage of mobile [I]nternet services by the subscriber," as taught by Corrigan et al., is equivalent to "a user action proxy that detects user actions ... and monitors each service subscribed to by the user **for a pattern common to at least two services**," as recited in the claimed invention. Monitoring a pattern of usage of multiple Internet services, without anything more, is simply not equivalent to monitoring each service subscribed to by a user for a pattern common to at least two services. Applicants have read all of Corrigan et al. and cannot find, in any context, a single implicit or explicit teaching related to determining a pattern common to at least two services. "Claims are not read to be read in a vacuum and while it is true they are to be given the broadest *reasonable* interpretation during prosecution, their terms still **have to be given** the meaning called for by the specification of which they form a part." See In re Royka, 180 USPQ 580, 582-583 (CCPA 1974) (emphasis added); MPEP 2143.03; see also page 19, paragraph 50 of Present Application ("user action proxy can interpret a combination of service activities to mean a particular event").

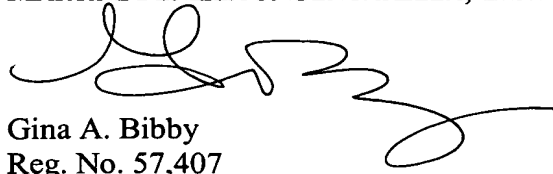
"To establish prima facie obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art." See MPEP § 2143.03 (emphasis added); see also In re Royka, 180 USPQ 580 (CCPA 1974); In re Vaeck, 20 USPQ2d 1438 (Fed. Cir.

1991). Accordingly, for at least the reasons stated above, Applicants submit that independent Claims 9, 22, 30, and Claims 10-17, 23-29, and 31-33 that respectively depend therefrom are patentable under 35 U.S.C. § 103(a) over Fano et al. in view of Corrigan et al. Applicants therefore respectfully request reconsideration, and withdrawal of the § 103 rejections.

### **Conclusion**

In view of the foregoing, the Applicant respectfully submits that all the pending Claims 9-17, and 22-33 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present amendment, the Examiner is requested to contact the undersigned at (408) 749-6920. If any additional fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. SUNMP324). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,  
MARTINE PENILLA & GENCARELLA, L.L.P.



Gina A. Bibby  
Reg. No. 57,407

Martine Penilla & Gencarella, LLP  
710 Lakeway Drive, Suite 200  
Sunnyvale, California 94085  
Telephone: (408) 774-6920  
**Customer Number 32291**